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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,296	03/07/2002	Akihiro Denda	Q68841	2668
23373	7590	10/12/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			AGUSTIN, PETER VINCENT	
			ART UNIT	PAPER NUMBER
			2652	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/092,296

**Applicant(s)**

DENDA ET AL.

**Examiner**

Peter Vincent Agustin

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

2. The drawings are objected to because on figure 1, element 3, "HARD DISK DRIVE B" should be --HARD DISK B--; and on figure 3, step S41, "EJEJCT" should be --EJECT--.
- Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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***Specification***

3. The disclosure is objected to because of the following informalities:

Page 1, second line of last paragraph: "an user" should be --a user--.

Page 2, first line: "id" should be --is--.

Appropriate correction is required.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Objections***

5. Claims 1-3 & 5-9 are objected to because of the following informalities:

Claim 1, line 9: "recording means" should be --recording medium--.

Claim 5, line 4: "temporary" should be --temporarily--.

Claim 5, line 8: "judges" should be --for judging--.

Claims 2, 3 & 6-9 are dependent upon objected base claims.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 4, 5 & 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (US 6,292,440).

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In regard to claim 4, Lee discloses an information reproducing method (inherent from the apparatus of figure 1) comprising: reproducing program information (MP3 Audio File) recorded on a first recording medium (CD/CD-ROM; see 100); temporarily copying the reproduced program information on a second recording medium (200; column 3, lines 24-25); reproducing the copied program information (500); judging that the program information is copied onto the second recording medium when the program information recorded on the first recording medium is reproduced (inherent: note that the program information is either copied onto the second recording medium, i.e., when an MP3 audio file is detected; or not copied onto the second recording medium, i.e., when an ordinary audio CD file is detected. The file type detector 100 involves receiving source data and detecting the type of data, i.e., the “program information is reproduced” in order to detect the type of data. See column 3, lines 38-43); and controlling reproducing of the program information recorded on the first recording medium to be stopped and the copied program information to be reproduced if it is judged that the program information is copied (inherent: note that in the case where an ordinary audio CD file is detected (column 3, lines 50-55), data is reproduced directly; and in the case where an MP3 audio file is detected (column 3, lines 56-59), the program information copied in the second recording medium 200 is reproduced by element 500, thus, element 100 does not directly reproduce the audio signal, i.e., it is stopped).

In regard to claim 5, Lee discloses an information reproducing apparatus (figure 1) comprising: a first reproducer (100) for reproducing program information (MP3 Audio File) recorded on a first recording medium (CD/CD-ROM); a driver (inherent from column 3, lines 24-25: the claimed “driver” would be the inherent element that enables memory block 203 to

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receive the MP3 audio files) for temporarily copying on a second recording medium (200) the program information reproduced by the first reproducer; a second reproducer (500) for reproducing the program information on the second recording medium; and a controller for judging that the driver copies the program information to be reproduced onto the second recording medium (inherent: note that the program information is either copied onto the second recording medium, i.e., when an MP3 audio file is detected; or not copied onto the second recording medium, i.e., when an ordinary audio CD file is detected. The file type detector 100 involves receiving source data and detecting the type of data, i.e., the “program information is reproduced” in order to detect the type of data. See column 3, lines 38-43), wherein the controller controls the first reproducer not to reproduce the program information on the first recording medium and the second reproducer to reproduce the program information on the second recording medium if the second recording medium contains the program information (inherent: note that in the case where an ordinary audio CD file is detected (column 3, lines 50-55), data is reproduced directly; and in the case where an MP3 audio file is detected (column 3, lines 56-59), the program information copied in the second recording medium 200 is reproduced by element 500, thus, element 100 does not directly reproduce the audio signal, i.e., it is stopped).

In regard to claim 7, Lee inherently suggests that the controller controls the second reproducer not to reproduce the program information when the first recording medium is not mounted into the first reproducer. It should be noted that the claimed “program information” is copied from the first recording medium. Therefore, when the first recording medium is not mounted, no program information is copied, and the second reproducing means would have

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nothing to reproduce, i.e., the control means automatically controls the second reproducing means not to reproduce in the absence of the first recording medium. In this case, when the CD/CD-ROM of figure 1 is not mounted, the file type detector 100 would not detect an MP3 Audio File or an Ordinary Audio CD File, and the MP3 Decoder 500 would have nothing to reproduce.

In regard to claim 8, Lee discloses that the first reproducer is a CD player (abstract, line 4; figure 1: CD/CD-ROM).

In regard to claim 9, Lee discloses that the second reproducer is a hard disk drive unit (column 3, line 60 thru column 4, line 9).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Hira (US 5,392,264).

For a description of Lee, see the rejection above. Furthermore, in regard to claim 6, Lee inherently discloses that the driver deletes the program information from the second recording medium. Note that the phrase "temporarily stores the files" recited in column 3, line 25 suggests that the files are going to be erased eventually, i.e., the files are not stored permanently in the second recording medium. However, in regard to claim 6, Lee is silent to whether the driver

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deletes the program information from the second recording medium when the first recording medium is removed from the first reproducer.

Hira discloses clearing data contents from a memory when an operation indication of discharging a recording medium is detected or when a tray is opened and closed (see column 12, lines 9-13), i.e., the claimed “deletes the program information from the second recording medium when the first recording medium is removed from the first reproducer”. It would have been obvious to one of ordinary skill in the art at the time of invention to have deleted the program information of Lee when the first recording medium is removed as suggested by Hira, the motivation being to prevent memory overflow and/or to provide sufficient memory space for subsequent operations, which is a well-known purpose of clearing contents of memory.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Smith (US 4,872,151) discloses a compact disc player having a means for storing an order of play data into a memory and retrieving the stored play data.

Shinada (US 5,502,700) discloses a system comprising a temporary storage for storing data read from a magneto-optical disc.

Sako (US 5,694,381) discloses a method wherein data reproduced from a recording medium is temporarily stored in a hard disc and then all of the data stored in the hard disc is recorded onto a recording medium, in order to record efficiently without error.

Takenaka (US 5,881,041) discloses an apparatus for copying information from a first recording medium to a second recording medium.



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Inaba (JP 58164059) discloses clearing the content of a memory whenever a door is opened.

*Allowable Subject Matter*

11. Claims 1-3 are allowed over the prior art of record.
12. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest:

In claim 1, a judgement means for judging that the program information is copied onto the second recording medium when the program information is reproduced by the first reproducing means; and control means for controlling reproduction of the program information recorded on the first recording medium to be stopped and the program information copied in the second recording medium to be reproduced if it is judged that the program information is copied.

Claims 2 & 3 are dependent upon claim 1.

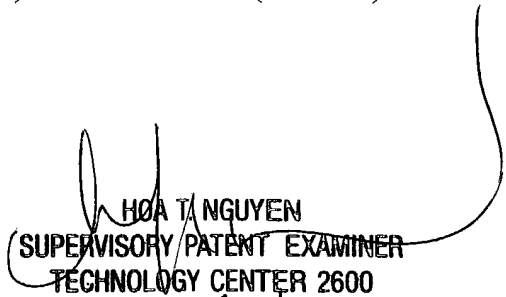
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 703-305-8980. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin  
Art Unit 2652  
September 22, 2004

  
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